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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

PANNALA, SATHYANARAYA R

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/052,735

Applicant(s)

SESEK ET AL.

Examiner

Sathyanarayan Pannala

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Application's Amendment filed on 9/27/2004 has been entered with claims 1, 6, 15 and 22 being amended. Claims 1-26 are pending in this Office Action.

Specification

2. Applicant's revised abstract in reply filed on 9/27/2004 is acknowledged and will be entered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 10-15, 19-22 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Nielsen (US Patent 5870548) hereinafter Nielsen.

5. As per independent claim 1, Nielsen anticipated by teaching a computer controlled method for allowing an email sender to alter a previously sent email message addressed to a recipient whose computer is beyond control of the sender's computer

(col. 3, lines 10-14). Nielsen teaches the claimed step of “determining whether a user sent a copy of a document as an email attachment to a first set of at least one recipient via email” as once the email message is created, it passes to an email transmission facility 203. A copy of the email is saved in the sender’s outbox 204 in the ending email system 200 (Fig. 2, col. 6, lines 22-25). Further, Nielsen teaches the claimed step of “if the user sent the copy of the document to the at least one recipient of the first set, correlating information with the document so that a copy of a revised version of the document can be sent automatically as another email attachment to the at least one recipient of the first set” as depending on the sender’s selections, the sender’s email program constructs an action message 409 targeted toward the previously sent message, and send this constructed action message to the same recipients as the previously sent message (Fig. 4, col. 7, lines 13-17).

6. As per dependent claim 2, Nielsen teaches the claimed step of “correlating comprises encoding the document with the information” as the sender’s email program provides a mechanism that allows the sender to select a previously sent message 503 (Fig. 5, col. 7, lines 22-25).

7. As per dependent claim 3, Nielsen teaches the claimed step of “the information comprises a location of the document in a device in which the document was created” as a sender creates a message using an email composition facility 201 on the sender’s system 200 (Fig. 2, col. 6, lines 20-22).

8. As per dependent claim 4, Nielsen teaches the claimed step of “the information comprises a location of the document in a device from which the document was sent” as a copy of the email is saved in the sender’s outbox 204 in the sending email system 200 (Fig. 2, col. 6, lines 23-25).

9. As per dependent claim 5, Nielsen teaches the claimed step of “the information comprises addresses of the at least one recipient of the first set” as a computer controlled method for allowing an email sender to alter a previously sent electronic message addressed 611 to a recipient whose computer is beyond the control of the sender (Fig. 6B, col. 3, lines 10-14).

10. As per dependent claim 10, Nielsen teaches the claimed step of “automatically enabling the at least one recipient of the first set to obtain the copy of the revised version of the document if the at least one recipient of the first set accesses the copy of the document” as the modified message is sent 763 to the recipient using the previously sent message 659 (Fig. 6A, 7B, col. 11, lines 12-15) and the message database keeps track of messages received location and where the message stored and the modified previously sent message in the modified record (Fig. 8A,C, col. 12, lines 39-41). Further, Nielsen teaches the comparison of modified previously sent message with modified database record (Fig. 9, col. 14, lines 9-13).

11. As per dependent claim 11, Nielsen teaches the claimed step of “providing a graphical user interface enabling a user to select an option to obtain the copy of the revised version of the document upon accessing the copy of the document” as the most computer systems provide a GUI to evoking commands or computer operations (col. 5, lines 21-25).

12. As per dependent claim 12, Nielsen teaches the claimed step of “selecting a threshold, the attainment of which enables the copy of the revised version of the document to be obtained upon accessing the copy of the document” as the recipient if not seen the previously sent message before receiving the modified message, the previously sent message will be deleted and modified message is saved (Fig. 11A, col. 16, lines 16-23).

13. As per dependent claim 13, Nielsen teaches the claimed step of “the threshold is one of a date, a day, and a time” as the seven days are considered as threshold period for deleting previous email after receiving the revised email (Fig. 8D, 11B, col. 17, lines 17-20).

14. As per dependent claim 14, Nielsen teaches the claimed step of “providing a graphical user interface that allows the user to change the information so that the at least one recipient of the first set receives the copy of the revised version of the document every time the at least one recipient accesses the copy of the document” as

the selectable control area "Modify This Message" 677 activates the process of allowing the user to edit the message (Fig. 6D, col. 9, lines 12-22).

15. As per independent claim 15, Nielsen anticipated by teaching a computer controlled system for allowing an email sender to alter a previously sent email message addressed to a recipient whose computer is beyond control of the sender's computer (col. 3, lines 10-14). Nielsen teaches the claimed "a document-sending system" as a computer system configured to support an email application (Fig. 1B, col. 6, lines 5-9). Further, Nielsen teaches the claimed "determine whether a user sent a copy of a document attached to an email message to a first set of at least one recipient via email" as once the email message is created, it passes to an email transmission facility 203. A copy of the email is saved in the sender's outbox 204 in the ending email system 200 (Fig. 2, col. 6, lines 22-25); Further, Nielsen teaches the claimed "correlate information with the document so that a copy of a revised version of the document can be sent automatically as an attached to another email message, if the user sent the copy of the document to the at least one recipient of the first set" as depending on the sender's selections, the sender's email program constructs an action message 409 targeted toward the previously sent message, and send this constructed action message to the same recipients as the previously sent message (Fig. 4, col. 7, lines 13-17).

16. As per dependent claim 19, Nielsen teaches the claimed step of "automatically enabling the at least one recipient of the first set to obtain the copy of the revised

version of the document if the at least one recipient of the first set accesses the copy of the document” as the modified message is sent 763 to the recipient using the previously sent message 659 (Fig. 6A, 7B, col. 11, lines 12-15) and the message database keeps track of messages received location and where the message stored and the modified previously sent message in the modified record (Fig. 8A,C, col. 12, lines 39-41). Further, Nielsen teaches the comparison of modified previously sent message with modified database record (Fig. 9, col. 14, lines 9-13).

17. As per dependent claim 20, Nielsen teaches the claimed step of “selecting a threshold, the attainment of which enables the copy of the revised version of the document to be obtained upon accessing the copy of the document” as the recipient if not seen the previously sent message before receiving the modified message, the previously sent message will be deleted and modified message is saved (Fig. 11A, col. 16, lines 16-23).

18. As per dependent claim 21, Nielsen teaches the claimed step of “provides a graphical user interface that allows the user to change the information so that the at least one recipient of the first set receives the copy of the revised version of the document every time the at least one recipient accesses the copy of the document” as the selectable control area “Modify This Message” 677 activates the process of allowing the user to edit the message (Fig. 6D, col. 9, lines 12-22).

19. As per independent claim 22, Nielsen anticipated by teaching a computer controlled method and storage medium for allowing an email sender to alter a previously sent email message addressed to a recipient whose computer is beyond control of the sender's computer (col. 3, lines 10-14). Nielsen teaches the claimed "logic configured to determine whether a user sent a copy of a document attached to an email message to a first set of at least one recipient via email" as once the email message is created, it passes to an email transmission facility 203. A copy of the email is saved in the sender's outbox 204 in the ending email system 200 (Fig. 2, col. 6, lines 22-25). Further, Nielsen teaches the claimed "logic configured to correlate information with the document so that a copy of a revised version of the document can be sent automatically attached to another email message, the logic correlates the information if the user sent the copy of the document to the at least one recipient of the first set" as depending on the sender's selections, the sender's email program constructs an action message 409 targeted toward the previously sent message, and send this constructed action message to the same recipients as the previously sent message (Fig. 4, col. 7, lines 13-17).

20. As per dependent claim 26, Nielsen teaches the claimed step of "logic configured to automatically enable the at least one recipient of the first set to obtain the copy of the revised version of the document, the logic automatically enables if the at least one recipient of the first set accesses the copy of the document" as the modified message is sent 763 to the recipient using the previously sent message 659 (Fig. 6A, 7B, col. 11,

lines 12-15) and the message database keeps track of messages received location and where the message stored and the modified previously sent message in the modified record (Fig. 8A,C, col. 12, lines 39-41). Further, Nielsen teaches the comparison of modified previously sent message with modified database record (Fig. 9, col. 14, lines 9-13).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

22. Claims 6-9, 16-18, 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US Patent 5,870,548) hereinafter Nielsen and in view of Naylor et al. (US Patent 6,625,642) hereinafter Naylor.

23. As per dependent claim 6, Nielsen teaches the claimed step of “appending the information with addresses of the at least one recipient of the second set, if the user sent the copy of the document to the at least one recipient of the second set” as the user can select a previously sent email 659 for sending revised documents (Fig. 6A, col. 7, lines 51-54). Nielsen teaches sending an email and resending the revised email to same recipients and do not explicitly teach sending the same mail to additional recipients. However, Naylor teaches the claimed step of “determining whether the user sent the copy of the document to at least one recipient of a second set” as the server sends the email after stripping the tags and associated data (Fig. 1, col. 9, lines 28-36). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention to incorporate the teachings of the cited references because the process of transmitting email by Naylor would have provided Nielsen’s with necessary method, which would allow the sender to send the messages to all recipients at one time. Further, by combining Naylor’s method would have allowed Nielsen’s method to send emails to one or several recipients (col. 2, lines 4-6).

24. As per dependent claim 7, Nielsen teaches the claimed step of “appending the information with addresses of the at least one recipient of the third set, if the at least one recipient of the second set sent the copy of the document to the at least one recipient of the third set” as the user can select a previously sent email 659 for sending revised document (Fig. 6A, col. 7, lines 51-54). Nielsen teaches sending an email and

resending the revised email to same recipients and do not explicitly teach sending the same mail to additional recipients. However, Naylor teaches the claimed step of “determining whether the at least one recipient of the second set sent the copy of the document to at least one recipient of a third set” as the forwarding the emails to appropriate recipients (Fig. 3, col. 9, lines 57-62). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention to incorporate the teachings of the cited references because the process of transmitting email by Naylor would have provided Nielsen’s with necessary method, which would allow the sender to send the messages to all recipients at one time. Further, by combining Naylor’s method would have allowed Nielsen’s method to send emails to one or several recipients (col. 2, lines 4-6).

25. As per dependent claim 8, Nielsen teaches the claimed step of “the copy of the revised version of the document to be sent to the at least one recipient of the first, second, and third sets when the revised version of the document is saved” as the user can select a previously sent email 659 for sending revised document (Fig. 6A, col. 7, lines 51-54).

26. As per dependent claim 9, Nielsen teaches the claimed step of “providing a graphical user interface enabling the user to choose an option to send the copy of the revised version of the document” as the most computer systems provide a GUI to evoking commands or computer operations (col. 5, lines 21-25).

27. As per dependent of claim 16, Nielsen teaches the claimed “append the information with addresses of the at least one recipient of the second set, if the user sent the copy of the document to the at least one recipient of the second set” as the user can select a previously sent email 659 for sending revised documents (Fig. 6A, col. 7, lines 51-54). Nielsen teaches sending an email and resending the revised email to same recipients and do not explicitly teach sending the same mail to additional recipients. However, Naylor teaches the claimed “determine whether the user sent the copy of the document to at least one recipient of a second set” as the server sends the email after stripping the tags and associated data (Fig. 1, col. 9, lines 28-36). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention to incorporate the teachings of the cited references because the process of transmitting email by Naylor would have provided Nielsen’s with necessary method, which would allow the sender to send the messages to all recipients at one time. Further, by combining Naylor’s and Nielsen’s systems, would have allowed Nielsen’s system to send emails to one or several recipients (col. 2, lines 4-6).

28. As per dependent of claim 17, Nielsen teaches the claimed “append the information with addresses of the at least one recipient of the third set, if the at least one recipient of the second set sent the copy of the document to the at least one recipient of the third set” as the user can select a previously sent email 659 for sending revised document (Fig. 6A, col. 7, lines 51-54). Nielsen teaches sending an email and

resending the revised email to same recipients and do not explicitly teach sending the same mail to additional recipients. However, Naylor teaches the claimed “determine whether the at least one recipient of the second set sent the copy of the document to at least one recipient of a third set” as the forwarding the emails to appropriate recipients (Fig. 3, col. 9, lines 57-62). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention to incorporate the teachings of the cited references because the process of transmitting email by Naylor would have provided Nielsen’s with necessary method, which would allow the sender to send the messages to all recipients at one time. Further, by combining Naylor’s and Nielsen’s systems, would have allowed Nielsen’s system to send emails to one or several recipients (col. 2, lines 4-6).

29. As per dependent of claim 18, Nielsen teaches the claimed “the copy of the revised version of the document to be sent to the at least one recipient of the first set when the revised version of the document is saved” as the user can select a previously sent email 659 for sending revised document (Fig. 6A, col. 7, lines 51-54).

30. As per dependent claim 23, Nielsen teaches the claimed “the logic configured to append the information with addresses of the at least one recipient of the second set, the logic appends if the user sent the copy of the document to the at least one recipient of the second set” as the user can select a previously sent email 659 for sending revised documents (Fig. 6A, col. 7, lines 51-54). Nielsen teaches sending an email and resending the revised email to same recipients and do not explicitly teach sending

the same mail to additional recipients. However, Naylor teaches the claimed “logic configured to determine whether the user sent a copy of the document to at least one recipient of the second set” as the server sends the email after stripping the tags and associated data (Fig. 1, col. 9, lines 28-36). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention to incorporate the teachings of the cited references because the process of transmitting email by Naylor would have provided Nielsen’s with necessary method, which would allow the sender to send the messages to all recipients at one time. Further, by combining Naylor’s method and Nielsen’s method would have allowed Nielsen’s method to send emails to one or several recipients (col. 2, lines 4-6).

31. As per dependent claim 24, Nielsen teaches the claimed “logic configured to append the information with addresses of the at least one recipient of the third set, the logic appends if the user sent the copy of the document to the at least one recipient of the second set sent the copy of the document to the at least one recipient of the third set” as the user can select a previously sent email 659 for sending revised document (Fig. 6A, col. 7, lines 51-54). Nielsen teaches sending an email and resending the revised email to same recipients and do not explicitly teach sending the same mail to additional recipients. However, Naylor teaches the claimed step of “logic configured to determine whether the at least one recipient of the second set sent the copy of the document to at least one recipient of a third set” as the forwarding the emails to appropriate recipients (Fig. 3, col. 9, lines 57-62). Thus, it would have been obvious to

one of ordinary skill in the data processing art at the time of the invention to incorporate the teachings of the cited references because the process of transmitting email by Naylor would have provided Nielsen's with necessary method, which would allow the sender to send the messages to all recipients at one time. Further, by combining Naylor's method and Nielsen's method, would have allowed Nielsen's method to send emails to one or several recipients (col. 2, lines 4-6).

32. As per dependent claim 25, Nielsen teaches the claimed "logic configured to automatically enable the copy of the revised version of the document to be sent to the at least one recipient of the first set, the logic automatically enables when the revised version of the document is saved" as the user can select a previously sent email 659 for sending revised document (Fig. 6A, col. 7, lines 51-54).

Response to Arguments

33. Applicant's arguments filed 9/27/2004 have been fully considered but they are not persuasive. The details are as follows:

- a) Applicant's argument stated as "Nielsen involves alteration of an email message, not an email attachment."

In response to the Applicant's argument regarding claim 1, Examiner respectfully disagrees because the document attached to the email is very simple to modify, the importance is the ability to send an email to the same recipients.

Mere adding one or two words to differ from the prior art will not effect the prior art. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

b) Applicant's argument stated as "Applicants respectfully assert that Nielsen does not teach or reasonably at least the additional features/limitations emphasized above in claim 7."

In response to the Applicant's argument regarding claim 1, Examiner respectfully disagrees because the claim 7, "appending the information..." is taught Nielsen at (Fig. 6A, col. 7, lines 51-54). The other limitation "Determining..." is taught by Naylor at (Fig. 3, col. 9, lines 57-62).

c) Applicant's argument stated as "Specifically, Applicants respectfully assert that the combination Nielsen and Naylor is legally deficient..." see page 13, paragraph last.

In response to the Applicant's argument regarding claim 1, Examiner respectfully disagrees because the prior art by Naylor is combined with Nielsen to teach the claims or part of a claim which is not taught by Nielsen. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when

the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion


34. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sathyanarayan Pannala
Examiner
Art Unit 2167

srp
February 28, 2005

